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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,453	04/05/2004	David Naccache	032326-050	1613

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EXAMINER

DARROW, JUSTIN T

ART UNIT PAPER NUMBER

2132

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/817,453	Applicant(s) NACCACHE ET AL.	
	Examiner Justin T. Darrow	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-23 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-23 have been presented for examination. Claims 1-10, 13, 15, and 18 have been amended, and claims 11 and 12 have been canceled in a preliminary amendment. Claims 1-10 and 13-23 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in France on 02/19/1997. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in France on 02/19/1997. It is noted, however, that applicant has not filed a certified copy of the 97/02244 application as required by 35 U.S.C. 119(b).

4. Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 365(a) based upon a PCT international application filed on 02/17/1998. A claim for priority under 35 U.S.C. 365(a) cannot be based on said application, since the United States application was filed more than twelve months thereafter. Acknowledgment is made of applicant's claim for foreign priority based on a PCT international application filed on 02/17/1998. It is noted, however, that applicant has not filed a certified copy of the PCT/FR98/00304 application as required by 35 U.S.C. 365(a).

6. The applicant must perfect the claim for foreign priority under 35 U.S.C. 371 in order to benefit from the earliest filing date 02/19/1997. See MPEP § 1893. Specific question

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concerning foreign priority can be directed to Robert C. Clark of the Office of Patent Legal Administration at (703) 305-9177 by telephone or robert.clark@uspto.gov by e-mail.

Oath/Declaration

7. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

the applicant, Francoise Levy-Dit-Vehel, has not signed the declaration, filed 04/25/2001, Paper No. 4. The letter submitted with this declaration stated that a petition pursuant to 37 C.F.R. 1.47 would be forthcoming. No petition has been received.

Drawings

8. Figures 1-3 described in the specification (see page 25, lines 24-34) are missing. Formal drawings are required in this application. The formal drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for formal drawings will not be held in abeyance.

Claim Objections

9. Claim 3 is objected to because of the following informality: insert before "m" on page 29, line 19, --a message--. Appropriate correction is required.

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10. Claim 5 is objected to because of the following informality: delete "or 5" in page 30, line

16. Appropriate correction is required.

11. Claim 6 is objected to because of the following informalities:

after "4" in page 30, line 29, insert --or 5--; and

delete "or 5" in page 30, line 31. Appropriate correction is required.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-10, the phrase "so-called" in claim 1, page 28, lines 3-4, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

14. Claims 4-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "the decrypter" in page 29, line 29. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by deleting the second "the" in page 29, line 29 and replacing with --a--.

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Claim 4 recites the limitation "the escrow center" in page 29, lines 29-30. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by deleting the third "the" in page 29, line 29 and replacing with --an--.

Claim 4 recites the limitation "the message" in page 30, line 11. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by deleting the first "the" in page 30, line 29 and replacing with --a--.

15. Claims 8 and 10/8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites the limitation "the El-Gamal cryptogram" in page 32, lines 10-11. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by deleting the second "the" in page 32, line 10 and replacing with --an--.

Claim 8 recites the limitation "the encrypter" in page 32, line 11. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by deleting the first "the" in page 32, line 11 and replacing with --an--.

16. Claims 9 and 10/9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9 and 10/9, the phrase "so-called" in claim 9, page 33, lines 4-5, renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 9 recites the limitation "the parties" in page 33, line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

17. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are drawn to a method and system, respectively, with elements outside the scope of observable and tangible objects. See *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998).

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 1-10 and 13-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gemplus SCA (Naccache et al.) French Patent Application Publication No. FR 2 759 806 A1.

The declaration filed 04/25/2001 admits that the French Patent Application No. FR 97 02244 corresponding to this publication supports the claims.

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This rejection can be overcome by perfecting the claim for foreign priority as discussed above.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (571) 272-3801, and whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (571) 272-3799.

The fax number for Formal or Official faxes to Technology Center 2100 is 571-273-8300. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to 571-273-8300 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an

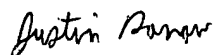
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amendment after final rejection have printed not only **“OFFICIAL FAX”** but also **“AMENDMENT AFTER FINAL”**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

December 12, 2005


JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100